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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,533

Applicant(s)

CHANDRA ET AL.

Examiner

Igor Borissov

Art Unit

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 28-36 are objected to because of the following informalities:

Claim 28. Examiner objects a term "*normalizing*" as being too broad. Examiner believes that the term "*normalizing*" refers to translating the input format of collected information into storing or output format.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The method step of: "*allocating supply risk among multiple wholesale suppliers*" is not disclosed in such a way to enable a person skilled in the art to realize the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is confusing, because the tem "*can*" indicates a potential, not an actual method step.

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Claim 26 is confusing, because it is not clear where is a preamble and where is a body of the claim.

Claim 27 is rejected as being dependent on claim 26.

Claim 33 is confusing, because it is not clear what method steps does the phrase "*allocating supply risk among multiple wholesale suppliers*" actually contemplate.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-36 are rejected under 35 U.S.C. 101 because the claimed method for *distributing a commodity to multiple users* does not recite a limitation in the technological arts. The independently claimed steps of: *receiving information on supply of a commodity at multiple distribution nodes, normalizing and storing said supply information; receiving and storing information on demand for said commodity by multiple users; matching said supply and demand information; and communicating matches to said multiple distribution nodes* are abstract ideas which can be performed mentally without interaction of a physical structure. The method steps: *receiving information on supply of a commodity at multiple distribution nodes and normalizing and storing said supply information* may be understood as merely keeping notes about electricity usage. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17, 26-32 and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (US 6,598,029).

Johnson et al. (hereinafter Johnson) teaches an auction method and system for bidding for energy supply with request for service, comprising:

Claims 1 and 26. A central computer (*hub*) including a database for storing energy supply and demand related information, and logic (rules engine) for matching said information; and at least two distribution nodes, each communicating with said central processor (Figs. 2 and 11; C. 7, L. 25-27, 57-58; C. 11, L. 62-63).

Claim 2. Said system as in claim 1. Information as to *matching of supply with the aggregate demand* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claims 3-5. Said system, including a wholesale market and local distributors (C. 17, L. 59-60; C. 18, L. 20). Information as to *wholesale* distributor, and *wholesale*

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marketer is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 6. Said system as in claim 1. Information as to *wholesale marketing node communicating with said hub* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 7. Said system including commercial users and residential customers (C. 2, L. 55-59).

Claim 8. Said system including a communication link (channel) for communication with end users (C. 28, L. 33-34). Information as to *marketing* channel is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 9. Said system for trading natural gas (C. &, L. 50).

Claim 10. Said system including a communication link (channel) for communication with end users (C. 28, L. 33-34). Information as to *marketing* channel is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 11. Said system for trading energy as in claim 1. Information as to *petroleum fuel* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 12. Said system including a communication link (channel) for communication with end users (C. 28, L. 33-34). Information as to *marketing* channel is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claims 13-14. Said system for trading energy as in claim 1.

Claim 15. Said system for trading energy as in claim 1. Information as to *user substitutes use of one commodity for another commodity* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 16. A central computer (*hub*) adapted to communicate with remote nodes over the Internet, said computer including a database for storing energy supply and demand related information, logic (rules engine) for matching said information; and an interface for normalization of inputted information (Figs. 2 and 11; C. 7, L. 25-27, 57-58; C. 11, L. 62-63).

Claim 17. Said system as in claim 16.

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Claim 27. Said system as in claim 1.

Claim 28. Receiving at a central processor (Moderator) information of energy (electricity or natural gas) demand and energy supply (C. 7, L. 25-27, 57-58); normalizing (converting from received format into a destination format) at Moderator said received energy information (C. 22, L. 19-27); matching said received energy demand information with energy supply information (C. 22, L. 60-61), and communicating said matching results to sources of said accumulated energy information (C. 28, L. 27-39; 53-67).

Claim 29. Matching of supply with the *aggregated* demand of multiple users (C. 10, L. 40).

Claim 30. Inputting said information into software-derived template (*mapping of information*).

Claim 31. Providing a subscription (*enrolling*); and acquiring recurring demand information (C. 13, L. 66 – C. 14, L. 7).

Claim 32. Acquiring recurring supply information from a supplier (C. 12, L. 21-23).

Claims 35-36. Generating a billing statement for users, thereby inherently indicating collecting payment from said users (C. 28, L. 53 – C. 29, L. 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

Claim 34. Johnson teaches: winning provider is responsible to schedule a delivery of its power (C. 16, L. 49-51).

Johnson does not specifically teach confirming a delivery schedule.

The examiner points out that there is no indication in the specification that said feature (confirming a delivery) provides the advantage over the prior art. Without such indication, it appears that providing a confirmation of the delivery is an obvious matter of business choice.

Claims 18-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wallace et al. (US 6,643,705).

Claim 18. Johnson teaches all the limitations of claim 18, except specifically teaching that said central computer is structured in a hub and spoke architecture.

Wallace et al. (hereinafter Wallace) teaches a method and system for routing electronic messages, including a router and a plurality of remote nodes, said system is structured in a hub and spoke architecture (C. 7, L. 28-29).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson to include that said central computer is structured in a hub and spoke architecture, as disclosed in Wallace, because it would allow to deliver an electronic communication to multiple remote nodes in any order, as specifically stated in Wallace (C. 7, L. 37-40).

Claim 19. Said system including an additional control computer (8) employing decision rules (Fig. 1; C. 26, L. 13-14).

Claim 20. Said system as in claim 18, providing subscription (*enrolling*) functionality (C. 13, L. 66 – C. 14, L. 7).

Claim 21. Said system as in claim 18, providing acquiring recurring supply functionality (C. 12, L. 21-23).

Claim 23. Said system as in claim 18, providing scheduling functionality (C. 16, L. 49-51).

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Claim 24-25. Said system as in claim 18, providing billing and payment functionality (C. 28, L. 53 – C. 29, L. 8).

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Wallace in view of Lange (US 6,321,212).

Claim 22. Johnson and Wallace teach all the limitations of claims 22, except specifically teaching a risk management engine.

Lange teaches a method and system for energy trading, wherein risk management assessment is provided (C. 112, L. 58; C. 64, L. 57-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson and Wallace to include providing risk management for said energy trading system, because it would minimize the unexpected financial losses, thereby make the system more attractive to the participants.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Lange.

Claim 33. Johnson teaches all the limitations of claim 33, except specifically teaching a risk management engine.

Lange teaches said method and system for energy trading, wherein risk management assessment is provided (C. 112, L. 58; C. 64, L. 57-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson to include providing risk management for said energy trading system, because it would minimize the unexpected financial losses, thereby make the system more attractive to the participants.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

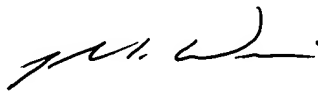
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



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